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Norman H. Stepno
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

WARE, TODD

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,015

Applicant(s)

BRETON ET AL.

Examiner

Todd D Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,30-32,35-37,41,42,52,55,56,62-64 and 66-125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 30-32, 35-37, 41-42, 52, 55, 56, 62-64, 66-87, 96-107, and 114-125 is/are rejected.
- 7) ☒ Claim(s) 88-95 and 108-113 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/216,862.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13 6) ☐ Other:

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DETAILED ACTION

Receipt of amendment and information disclosure statement filed 4-15-03 is acknowledged. Claims 27, 30-32, 35-37, 40, 41, 62, and 63 have been amended and claims 28-29, 33-34, 38-39, and 53-54 have been canceled as requested. New claims 66-125 have been added. Claims 27, 30-32, 35-37, 41-42, 52, 55, 56, 62-64, and 66-125 are pending.

Claim Objections

1. Claims 30-31, 35, 622-63, and 70-77 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The instant claims all recite the same compositions as the claim from which each depends where the only difference is the preamble intended use language. This language is not given patentable weight and does not limit the subject matter of the claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. **Claims 27, 30-31, 60-61, 66-67, 70-71, 74-77, 82-84 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Georgalas (EP 0 275 719; hereafter '719).**

4. '719 discloses compositions comprising cinnamic acid as a sunscreen in a cosmetically acceptable carrier (abstract; page 3, lines 11-16, page 4, line 10; example 1; claims).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 32, 35-36, 62, 68-69, 72-73, 78-81, 85-87, 96-101, 114-116, 118-120 are rejected 35 U.S.C. 103(a) as being unpatentable over Georgalas (EP 0 275 719; hereafter '719).**

7. '719 teaches compositions comprising cinnamic acid as a sunscreen in a cosmetically acceptable carrier (abstract; page 3, lines 11-16, page 4, line 10; example 1; claims). In example 1, '719 also teaches mixing of the UV-B absorbers. '719 does not explicitly teach ethyl cinnamate, but instead teaches the homolog methyl cinnamate. Accordingly, the claimed invention would have been obvious to one skilled in the art at the time of the invention because close structural similarity of the reference compound

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suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

8. Claims 37, 40, 41, 63, 102-107, 117, 121-124 are rejected 35 U.S.C. 103(a) as being unpatentable over Georgalas (EP 0 275 719; hereafter '719) in view of Lee et al (5,545,399; hereafter '399).

9. '719 is relied upon for all that it teaches as stated previously. '719 does not teach inclusion of another ingredient wherein the other ingredient is either a plant hormone or vitamin C.

10. '399 is relied upon for teaching inclusion of vitamin C (ascorbic acid) as a skin whitening agent in sunscreen formulations.

11. Accordingly, it would have been obvious to one skilled in the art at the time of the invention to include vitamin C in the formulation of '719 with the motivation of imparting a skin whitening component to this sunscreen formulation.

12. Claims 52, 55, 56, 65 are rejected 35 U.S.C. 103(a) as being unpatentable over Georgalas (EP 0 275 719; hereafter '719) in view of McAuslan (WO 88/01166; hereafter '166).

13. '719 is relied upon for all that it teaches as stated previously. It does not teach inclusion of a plant hormone in the formulation.

14. '166 teaches inclusion of anti-inflammatory plant hormones in topical compositions.

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15. Accordingly, it would have been obvious to one skilled in the art at the time of the invention to include a plant hormone in the formulation of '719 with the motivation of imparting an analgesic into the sunscreen to provide a sunscreen formulation that would also treat pain associated with sunburn.

16. **Claims 125 is rejected 35 U.S.C. 103(a) as being unpatentable over Georgalas (EP 0 275 719; hereafter '719) in combination with Lee et al (5,545,399; hereafter '399) and further in combination with McAuslan (WO 88/01166; hereafter '166).**

17. '719 and '399 are relied upon for all that they teach as stated previously. Neither of these references further teaches inclusion of a plant hormone.

18. '166 teaches inclusion of anti-inflammatory plant hormones in topical compositions.

19. Accordingly, it would have been obvious to one skilled in the art at the time of the invention to include a plant hormone in the combination of '719 and '399 with the motivation of imparting an analgesic into the sunscreen to provide a sunscreen/skin whitening formulation that would also treat pain associated with sunburn.

Response to Arguments

20. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

21. Claims 88-95, 108-113 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

22. Applicant is advised that should claim 27 be found allowable, claims 30-31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

23. Applicant is advised that should claim 32 be found allowable, claims 35, 62 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

24. Applicant is advised that should claim 37 be found allowable, claim 63 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

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one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

25. Applicant is advised that should claim 66 be found allowable, claims 70 and 74, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

26. Applicant is advised that should claim 67 be found allowable, claims 71 and 75, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

27. Applicant is advised that should claim 68 be found allowable, claims 72 and 76, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

28. Applicant is advised that should claim 69 be found allowable, claims 73 and 77, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When

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two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

29. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

30. Claims 27, 30-32, 35-37, 41-42, 52, 55, 56, 62-64, and 66-125 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 56-58 of copending Application No. 09/887,073.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim cinnamic acid compositions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

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31. Applicant's arguments filed 4-15-03 have been fully considered but they are not persuasive. Applicant has requested holding this rejection in abeyance until indication of allowable subject matter. Accordingly, the rejection is maintained.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd D Ware whose telephone number is (703) 305-1700. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703)308-2927. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

tw
June 29, 2003


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600